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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,603	04/28/2000	Mark R. Sendo	SSO-10002/29	4629

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John G Posa Esq
Gifford Krass Groh Sprinke Anderson & Citkowski PC
280 N Old Woodard Ave
Suite 400
Birmingham, MI 48009

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,603

Applicant(s)

SENDO ET AL.

Examiner

John M Winter

Art Unit

3621

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,9 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2,3,9 and 18-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 3621

DETAILED ACTION

STATUS

Claims 1, 4-8 has been canceled

Claims 2-3, 9 and 18-22 remain pending and are again presented for examination

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

In view of the paper 12 filed on 18 March 2004, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

The Applicant's arguments filed on April 28, 2003 have been fully considered

The presented claims are rejected in view of the newly discovered reference Yacobi (US Patent 5,511,121)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,9,18-22 are rejected under 35 U.S.C. 103(a) as being being unpatentable over Rowney et al. (US Patent 5,996,076) in view of Briscoe (US Patent 6,341,273) and further in view of Yacobi (US Patent 5,511,121).

As per claim 2,

Rowney et al. ('076) discloses a method as recited in claim 18,

Art Unit: 3621

wherein the recordable media is a medium capable of storing data for retrieval by a disk drive. (Figure 1A)

As per claim 3,
Rowney et al. ('076) discloses a method as recited in claim 2,
whereby the communications system is the Internet. (Column 4, lines 52-54)

As per claim 9,
Rowney et al. ('076) discloses a recordable media according to claim 18,
Official Notice is taken that "comprising dimensions approximately the size of a credit card" is common and well known in prior art in reference to data security. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the device would comprise the dimensions approximately the size of a credit card because this allows the consumer the convenience of carrying the device in a wallet or a purse. The examiner notes that the limitations of this claim are met by many smart cards.

As per claim 18,
Rowney et al. ('076) discloses a method of securely transferring data having a corresponding equivalent monetary value in a communications system including a first device having a first set of data encoded thereon, a second device having a second set of data thereon, and a third device having a third set of data encoded thereon, and a fourth device having a fourth set of data thereon, the method comprising the steps of:

Sending a request to the second device to perform a transaction via user interface (Column 14, lines 55-61).

transmitting the first set of data from the recordable media to the third device;(Figure 3—the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

transmitting a portion of the third set data to the fourth device. (Column 15, lines 45-53)

transmitting an instruction from the third device to the second device whereby the second device completes the transaction request according to a predetermined process. (Column 15, lines 45-53)

Rowney et al. ('076) does not specifically disclose retrieving comparing the first set of data to the third set of data for verification purposes. Yacobi. ('121) discloses comparing the first set of data to the third set of data for verification purposes (Figure 3 – 1st data set is message 'm', third data set is Banks maintained list). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Yacobi. ('121) method of using an electronic coin stick in order to prevent fraud.

Rowney et al. ('076) does not specifically disclose retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value. Briscoe. ('273) discloses retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value, (Figure 3). It would have been

Art Unit: 3621

obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Briscoe. ('273) method of using an electronic coin stick in order to create an anonymous form of electronic money.

As per claim 19,

Rowney et al. ('076) discloses a method of securely transferring data having a corresponding equivalent monetary value in a communications system including a first device having a first set of data encoded thereon, a second device having a second set of data thereon, and a third device having a third set of data encoded thereon, and a fourth device having a fourth set of data thereon, the method comprising the steps of:

Sending a request to the second device to perform a transaction via user interface (Column 14, lines 55-61).

transmitting the first set of data from the recordable media to the third device;(Figure 3—the merchant passes along data from the client, e.g. credit card information, thus the data is sent from the first device to the third device)

transmitting the first portion of the third set of data from the third device to the user interface;(Figure 3)

transmitting an instruction from the third device to the second device. (Column 15, lines 45-53)

transmitting a portion of the third set data to the fourth device for authentication purposes. (Column 15, lines 45-53)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit a second portion of the third set of data from the third device to the fourth device, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

transmitting an instruction from the fourth device to the second device whereby the second device completes the transaction request according to a predetermined process. (Column 15, lines 45-53)

Rowney et al. ('076) does not specifically disclose retrieving comparing the first set of data to the third set of data for verification purposes. Yacobi. ('121) discloses comparing the first set of data to the third set of data for verification purposes (Figure 3 – 1st data set is message 'm', third data set is Banks maintained list). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Yacobi. ('121) method of using an electronic coin stick in order to prevent fraud.

Rowney et al. ('076) does not specifically disclose retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value. Briscoe. ('273) discloses retrieving the first set of data from the recordable media at the user interface wherein the first data set includes at least one non-reusable token being the equivalent to a monetary value, (Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Briscoe. ('273) method of using an electronic coin stick in order to create an anonymous form of electronic money.

Art Unit: 3621

As per claim 20,
Rowney et al. ('076) discloses a method as recited in claim 18,
Official Notice is taken that "the recordable media optically recordable" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the recordable media optically recordable because recordable media (CDR) is inexpensive to use.

As per claim 21,
Rowney et al. ('076) discloses a method as recited in claim 18,
wherein the user interface is a personal computer. (Figure 1A)

As per claim 22,
Rowney et al. ('076) discloses a method as recited in claim 18,
Rowney et al. ('076) does not specifically disclose invalidating at least one non-reusable token from the recordable media after verification. Briscoe. ('273) discloses invalidating at least one non-reusable token from the recordable media after verification, (Column 6, lines 31-46) it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rowney et al. method of electronic commerce with the Briscoe. ('273) method of using an electronic coin stick in order to prevent fraud.

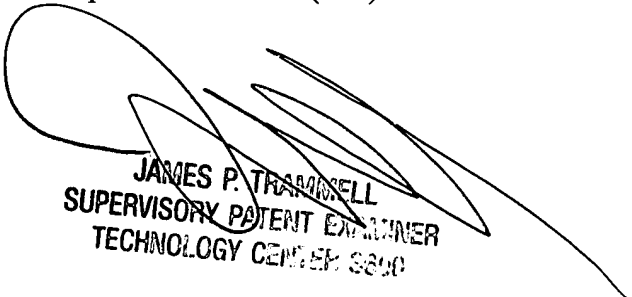
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
May 30, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 8200